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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Application of:
RICHARD P. METTKE
Serial No.: 09/134,831
Filed: August 17, 1998
Title: ON-LINE COMMUNICATION
TERMINAL/APPARATUS

November 3, 1998

Received
NOV 04 1998
Group 2700

ATTENTION:
Gerald Goldberg
Art Unit: 2700

2744 #8
P. Logan
4-28-99

Mr. Gerald Goldberg
Hon. Commissioner of Patents
and Trademarks
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

COVER LETTER

Enclosed is the Protest of TouchNet Information Systems, Inc under 37 C.F.R. § 1.291(a) related to Application for Reissue Serial No. 09/134,831. This Protest includes the following documents:

1. Protest of TouchNet Information Systems, Inc., under 37 C.F.R. § 1.291(a) including Exhibits A thru N.

2. Exhibit M, Affidavit of Daniel J. Toughey, President of Information Systems, Inc. verifying the dates of Exhibits A thru L.
3. PTO Form 1449 listing all documents submitted as Exhibits in this Protest.
4. Certificate of Service of transmittal of this Protest and exhibits to the Applicant's attorney of record in Application for Reissue Serial No. 09/134,831.

The attention of the Office to this Protest is respectfully requested.

Respectfully submitted,



Richard P. Stitt
Patent Office Reg. No. 35,693
SPENCER FANE BRITT & BROWNE, LLP
1000 Walnut Street, Suite 1400
Kansas City, MO 64106-2140
Telephone: 816-292-8129
Facsimile: 816-474-3216

Attorney for Protestor

PATENT

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Reissue Application of:
RICHARD P. METTKE

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United States Patent and Trademark Office
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Sir:

PROTEST UNDER 37 C.F.R. § 1.291(a)

1 This Protest under 37 C.F.R. § 1.291 is filed in Reissue Application Serial Number
2 09/134,831 by TouchNet Information Systems, Inc. of Lenexa, Kansas 66219, (referred to
3 hereinafter as "Protestor").

SUMMARY OF GROUNDS FOR PROTEST

Protestor, as its basis for this Protest, states that the attached Exhibits demonstrate:

1. Protestor was the first to invent the subject matter taught and claimed in the original patent as demonstrated by the documents attached hereto.

2. Protestor was the first to invent the subject matter taught and claimed in the reissue application as demonstrated by the documents attached hereto.

3. Protestor made public use and offered for sale, for more than one year prior to the date of the original application for patent upon which the present reissue application is based, the subject matter taught and claimed in the original patent and reissue application as demonstrated by the documents attached hereto.

**LISTING OF PATENTS, PUBLICATIONS
OR OTHER INFORMATION RELIED UPON**

A Copy of each below-listed item relied upon is attached hereto as required under 37 C.F.R. § 1.291 and listed on attached PTO Form 1449.

Exhibit A

U.S. Patent Application Sr. No. 07/600,712;
"Multi-Purpose Public Facsimile Transmission Terminal";
Filed October 19, 1990, by inventor John C. Massey, abandoned.

Exhibit B

Australian Patent Document No. AU-B-85947/91;
“Multi-Purpose Public Facsimile Transmission Terminal”;
Application No. 859471/91, Application Date October 18, 1991,
Published November 6, 1992.

Exhibit C

1993 Video Tape, titled TOUCHFAX AMERICA, recorded May 14, 1993
© 1993 TouchFax Information Services, Inc. Length 1 minute and 20 seconds
Including 8½ x 11 inch paper printouts of video frames from TOUCHFAX
AMERICA video tape

Exhibit C, 1

Printout of video frame from TOUCHFAX AMERICA video tape showing the
opening title and production date of the video tape of May 14, 1993.

Exhibit C, 2

Printout of video frame from TOUCHFAX AMERICA video tape showing a
consumer inserting a credit card into the TouchFax unit to activate the unit.

Exhibit C, 3

Printout of video frame from TOUCHFAX AMERICA video tape showing a frame from the video tape of Exhibit C which specifically advertises connection to the PRODIGY® Information Service, a well know on-line service provider in 1993.

Exhibit C, 4

Printout of video frame from TOUCHFAX AMERICA video tape showing a frame from the video tape of Exhibit C which specifically advertises connection to the Internet.

Exhibit C, 5

Printout of video frame from TOUCHFAX AMERICA video tape showing a user at a TouchFax unit using the keyboard and showing the credit card swipe device.

Exhibit C, 6

Printout of video frame from TOUCHFAX AMERICA video tape showing a second display of the PRODIGY® information service being offered on the device and being advertised in the video tape as an on-line service connection option.

Exhibit D

TouchFax Network Topography Diagram Sales Literature

© 1991 TouchFax Information Services, Inc.

Exhibit E

“TouchFax Provides The Ultimate in Place-Based Interactivity,”

Interactive World, October 1992, Article Reprint

Exhibit F.

1991 Brochure of TouchFax Information Systems, Inc.

Titled, “VISION....POWER...VERSATILITY”

© 1991 TouchFax Information Services, Inc.

Exhibit G

1992 Advertising Flyer of TouchFax Information Systems, Inc.

Titled: “High-Tech, High-Touch, TouchFax.”

© 1992 TouchFax Information Systems

Exhibit H

U.S. Patent No. 4,359,631 to Lockwood et al.

“Self-Service Terminal,” filed July 11, 1980; issued November 16, 1982.

Exhibit I

Office Actions from Exhibit A - U.S. Patent Application Sr. No. 07/600,712
“Multi-Purpose Public Facsimile Transmission Terminal”;
Filed October 19, 1990, by inventor John C. Massey, now abandoned.

Exhibit J

Letter to Ms Linda Lee Coyner of Bell South from John F. Murphy of TouchFax
Dated July 13, 1992 and offering for sale TouchFax terminals which connect to
PRODIGY®.

Exhibit K

Exhibit K is a true copy of the deposition of Daniel J. Toughey dated June 16,
1998 and taken in Richard P. Mettke vs. TouchNet Information Systems, Inc.
before the U.S. District Court for the Northern District of Alabama - Eastern
Division in Case No. CV 98-PT-596-E.

Exhibit L

Exhibit L is a true copy of the sworn deposition of John F. Murphy, Vice-President
of Market Development for TouchNet Information Systems, Inc., dated June 16,
1998 and taken in Richard P. Mettke vs. TouchNet Information Systems, Inc.
before the U.S. District Court for the Northern District of Alabama - Eastern
Division in Case No. CV 98-PT-596-E.

Exhibit M

Exhibit M is a true copy of the ORDER of U.S. District Court for the Northern District of Alabama - Eastern Division dismissing, with prejudice Plaintiff, Richard P. Mettke's claim of patent infringement against TouchNet Information Services, Inc. and ORDERING that plaintiff never again "assert United States patent No. 5,602,905 against defendant TouchNet Information Systems, Inc., its customers, licensees or assigns.

Exhibit N

Exhibit N is the Affidavit of Daniel J. Toughey which verifies the dates related to all exhibits presented in this Protest.

CONCISE EXPLANATION OF THE RELEVANCE OF EACH LISTED ITEM

Exhibit A.

U.S. Patent Application Sr. No. 07/600,712; titled "Multi-Purpose Public Facsimile Transmission Terminal"; filed October 19, 1990, by inventor John C. Massey, abandoned.

Exhibit A, teaches a public fax service available to the user at a credit card activated, free standing kiosk which would be located in any place frequented by the general public. The kiosk formed of stainless steel or other durable material construction to withstand public use and abuse.

1 Exhibit A further teaches providing such a terminal to act as part of a network to a remote
2 information data bank. Specifically, in Exhibit A, at page 10, lines 1-7, "An 'Electronic Library'
3 function displays menus for accessing various remote information sources and service applications
4 available via data communication lines." "When the user quits, the program prepares a bill
5 indicating all charges, time used and credit card information."

6 Exhibit A, at page 4-5, teaches the combination of a credit card reader 15 for enabling the
7 function of the machine 1, a scanner 16 for scanning a document to be transmitted, a fax modem
8 and data modem 17 for transmitting a scanned document and a computer 18 operably connected
9 to the scanner 16. An incoming telephone line 31 is routed through the power filter 29 also for
10 surge protection and ultimately wired to the telephone handset 21. The telephone handset 21 is
11 connected via a telephone hook switch 32 to the fax and data modem 17.

12 Exhibit A, page 6, lines 3-27, "The fax and data modem 17 is also mounted within the
13 computer 18 and is connected to its motherboard. The fax and data modem 17 includes a fax
14 card 53 which is preferably of 9600 BPS modem-MH coding. A data modem card 54 is
15 preferably Hays compatible and provides a suitable transmission rate such as 2,400 baud. A
16 jumper 55 connects the fax card 53 to the data modem card 54." A printer 19 and touch screen
17 monitor 20 also are included in the combination.

Exhibit B

Australian Patent Document No. AU-B-85947/91

"Multi-Purpose Public Facsimile Transmission Terminal"

Application No. 859471/91, Application Date October 18, 1991,

Publication Date: November 6, 1992

Exhibit B contains the same information as Exhibit A. Exhibit B became a published reference on November 6, 1992.

Exhibit C

1993 Video Tape, titled TOUCHFAX AMERICA, recorded May 14, 1993

© 1993 TouchFax Information Services, Inc. Length 1 minute and 20 seconds

Including 8½ x 11 inch paper printouts of video frames from TOUCHFAX

AMERICA video tape

Exhibit C is a video tape made in May of 1993 and distributed by TouchFax Information Services as advertising at the 1993 Comdex in Atlanta, Georgia. Exhibit C shows the stand alone Kiosks as they are used by the public. The video tape is advertising the use of the TouchFax Kiosks for a variety of purposes including pay-per-use access to the PRODIGY® Information Service and for connection to the Internet. These connection options are specifically identified on the video tape.

Exhibit C shows the device having the structure described in Exhibits A, B, D-G and J-L and being capable of connecting to an on-line service provider. The PRODIGY® on-line

1 information service is specifically advertised in the video tape at timings of 00:24:00 and 01:16:00
2 and 2:10:00 and 03:01:00.

3 The video tape also advertises that the device can be used for connection to the Internet.
4 The touch screen button titled "INTERNET" is shown in the video tape at timings of 00:34:50
5 and 02:19:50.

6 Protestor has provided printed copies (attached as Exhibit C,3 and C, 4 and C,6) of the
7 video tape frames which show the advertising of the PRODIGY® and Internet connections via
8 the advertised device.

9 For the convenience of the examiner, several individual frames from this video tape have
10 been isolated and printed in paper format and are attached hereto as Exhibits C,1 to C, 6. The
11 video tape timing location of each paper printout is contained in the lower right corner of each
12 printout.

13 **Exhibit C, 1**

14 Printout of video frame from TOUCHFAX AMERICA video tape showing the
15 opening title and production date of the video tape of May 14, 1993.

16 **Exhibit C, 2**

17 Printout of video frame from TOUCHFAX AMERICA video tape showing a
18 consumer inserting a credit card into the TouchFax unit to activate the unit.

19 **Exhibit C, 3**

1 Printout of video frame from Exhibit C, TOUCHFAX AMERICA video tape,
2 showing a frame which specifically advertises connection to the PRODIGY@
3 Information Service, a well know on-line service provider in 1993.

4 **Exhibit C, 4**

5 Printout of video frame from TOUCHFAX AMERICA video tape showing a
6 frame from the video tape of Exhibit C which specifically advertises connection to
7 the Internet.

8 **Exhibit C, 5**

9 Printout of video frame from TOUCHFAX AMERICA video tape showing a user
10 at a TouchFax unit using the keyboard and showing the credit card swipe device.

11 **Exhibit C, 6**

12 Printout of video frame from TOUCHFAX AMERICA video tape showing a
13 second display of the PRODIGY® information service being offered on the device
14 and being advertised in the video tape as an on-line service connection option.

Exhibit D

TouchFax Network Topography Diagram Sales Literature

© 1991 TouchFax Information Systems, Inc.

Exhibit D teaches use of a TF 750 Public Terminal as a data and communications system (see, description of TF 750 Public Terminal at Exhibit E, page 2, column 1, paragraph 2). Exhibit D teaches a system which includes a "TouchFax Electronic Library" which serves a "Gateway to Fax & Computer Services". The Computer Services include "on-line interactive data base" including "Public access to CompuServe, PRODIGY® Special interest -- USA Today Sports Center, BBS applications."

Exhibit E

"TouchFax Provides The Ultimate in Place-Based Interactivity,"

Interactive World, October 1992 Article Reprint

Exhibit E, pages 1-2, "All TouchFax terminals use proprietary software to create an easy-to-use visual control panel. This user interface to the machine is displayed on a touch-sensitive color video monitor which provides instructions to the user and on-screen buttons to operate the terminal functions."

Exhibit E, page 2, column 1, paragraph 2, "Payment for services is made by using credit card or other magnetic card such as a telephone calling card. The terminal provides a detailed printed receipt of the transaction for expense account record keeping.

1 Exhibit E, page 2, column 1, paragraph 3, TouchFax's TF 750 is a free-standing kiosk
2 with a high-resolution, 14-inch color touch screen monitor, 386 microprocessor, high-volume
3 laser printer, full-sized keyboard, and data port for modem and laptop connections.

4 Exhibit E, page 2, column 2, paragraph 2, "On a TouchFax public terminal, the touch
5 screen provides an interactive dialog between the consumer and the information provider." ...
6 "The TouchFax public terminal then sends the information via computer modem to OAG's
7 database and a one-page personalized report is delivered to the TouchFax terminal by facsimile.

8 Exhibit E teaches use of the TF750 device to connect to an on-line service provider of an
9 information database, specifically, the Official Airline Guide (OAG).

10 **Exhibit F**

11 **1991 Advertising Brochure of TouchFax Information Systems, Inc.**

12 **Title: "VISION...POWER...VERSATILITY..."**

13 **© 1991 TouchFax Information Services, Inc.**

14 Exhibit F teaches all the structure claimed in the present reissue application and teaches
15 the use of that structure to access computer databases. Therefore, the © 1991 printed publication
16 of Exhibit F is an anticipating reference with respect to the present reissue application under 35
17 U.S.C. § 102 (a) and (b).

18 Exhibit F at page 2, teaches a complete "public communications terminal" in a stand-alone
19 housing including a "credit card reader" for payment for services as they are used and further
20 specifies that the terminal as illustrated provides a "... touch screen window to a universe of

1 information available from on-line computer and fax information services” a “386 CPU with 40
2 megabyte hard drive,... and data modem capabilities”; a “300 DPI Laser Printer”; and a “14”
3 Color Touch screen Monitor.”

4 Exhibit F at page 2 also teaches “access to a growing network of information databases
5 from Wall Street news to international sports scores” and that the “full-sized keyboard extends for
6 computer database access or word processing...”

7 While Exhibit F does not teach, in particular, connection to the Internet as sought to be
8 claimed by the reissue applicant, the selection of the Internet represents merely a user choice of a
9 particular database network. However, the publication of Exhibit F in combination with
10 publication of Exhibit C makes obvious any claim to connecting to the Internet from a pay-per-
11 use kiosk.

12 **Exhibit G**

13 **1992 Advertising Flyer of TouchFax Information Systems, Inc.**

14 **Titled: “High-Tech, High-Touch, TouchFax:”**

15 **© 1992 TouchFax Information Systems**

16 Exhibit G teaches a stand-alone kiosk terminal for public access to communications
17 services including touch screen services, optional keyboard and RJ-11 data port provide
18 interactive access to private E-mail, word processing and a universal connection to computer-
19 based services.”

Exhibit H

U.S. Patent No. 4,359,631 to Lockwood et al.

Entitled "Self-Service Terminal," filed July 11, 1980; issued November 16, 1982.

The teachings of Exhibit H are identified by Senior Primary Examiner George H. Miller, Jr. and Supervisory Patent Examiner, Edward L. Coles, Sr. and Examiner Scott A. Rogers in the Office Action related to U.S. Patent Application Sr. No. 07/600,712, titled "Multi-Purpose Public Facsimile Transmission Terminal" and Filed October 19, 1990, by inventor John C. Massey, abandoned.

This Office Action is attached hereto as Exhibit I.

Exhibit I

Office Actions from Exhibit A - U.S. Patent Application Sr. No. 07/600,712

"Multi-Purpose Public Facsimile Transmission Terminal";

Filed October 19, 1990, by inventor John C. Massey, now abandoned.

Senior Primary Examiner George H. Miller, Jr., in an Office Action related to U.S. Patent Application Sr. No. 07/600,712 stated the following regarding Exhibit H, Lockwood U.S. Patent 4,359,631:

"Lockwood discloses a kiosk containing devices including a credit card reader, display screen, user data input and control means, information vending means, communication means, microprocessor, programmable memory, pre-stored information, and dynamic memory for user access, control and information exchange."

1 The analysis of Senior Primary Examiner George H. Miller, Jr. was confirmed in a Final
2 Action by Supervisory Patent Examiner, Edward L. Coles, Sr. and Examiner Scott A. Rogers
3 included in Exhibit I.

4 **Exhibit J**

5 **Sales Letter to Ms Linda Lee Coyner of Bell South from John F. Murphy of**
6 **TouchFax Dated July 13, 1992**

7 Exhibit K is a sales letter from John F. Murphy, Marketing Manager of TouchFax, to the
8 Vice President of Sales and Marketing for Bell South in Atlanta, Georgia. The letter is dated July
9 13, 1992 and offers to Bell South, in the last paragraph of the letter, a terminal which can
10 “communicate voice for calls and audio text services, images for fax transmissions as well as
11 documents stored in the hard drive, and data transmissions like E-mail and access to
12 PRODIGY®. PRODIGY® was a well known on-line computer information service and included
13 either at the time, or subsequently, connection to the Internet.

14 **Exhibit K**

15 Exhibit K is a true copy of the deposition of Daniel J. Toughey dated June 16, 1998 and
16 taken in Richard P. Mettke vs. TouchNet Information Systems, Inc. before the U.S. District Court
17 for the Northern District of Alabama - Eastern Division in Case No. CV 98-PT-596-E.

18 Exhibit K provides sworn testimony of the following facts at page 83, line 24 thru page
19 96, line 1:

20 Testimony of Mr. Toughey that all structure taught and claimed in the present

1 Application for Reissue was contained in the TouchFax terminal and that terminal
2 was capable of connecting to on-line database services such as PRODIGY on a
3 pay-per-use basis and such an offer for sale of a credit card based, pay-per-use
4 device was made to PRODIGY. PRODIGY accepted the offer, but elected to rely
5 upon their own user account numbers for charging the user.

6 Exhibit K provides sworn testimony of the following facts at page 43 thru page 49:

7 Testimony of Mr. Toughy that the video tape submitted in this Protest as Exhibit
8 C advertised connection to the Internet as an option available on the terminal and
9 that the video tape was produced on May 14, 1993 and that several hundred
10 copies of the video tape were distributed at the Spring COMDEX which was in
11 June of 1993.

12 **Exhibit L**

13 Exhibit L is a true copy of the sworn deposition of John F. Murphy, Vice-President of
14 Market Development for TouchNet Information Systems, Inc., dated June 16, 1998 and taken in
15 Richard P. Mettke vs. TouchNet Information Systems, Inc. before the U.S. District Court for the
16 Northern District of Alabama - Eastern Division in Case No. CV 98-PT-596-E.

17 Exhibit K provides sworn testimony of the following facts at page 7, line 24 thru page 9,
18 line 21 and at page 21, line 1 thru page 37:

19 Testimony of Mr. John Murphy, that the TouchFax terminal had the ability, and
20 did, to connect to PRODIGY in 1993 and that this same terminal could connect to

1 the Internet via PRODIGY and that any pay-per-use connection to the Internet
2 would have to be via a service provider such as PRODIGY, as there is no "Internet
3 entity" to charge for pay-per-use connection to the Internet.

4 **Exhibit M**

5 Exhibit M is a true copy of the ORDER of U.S. District Court for the Northern District of
6 Alabama - Eastern Division dismissing, with prejudice Plaintiff, Richard P. Mettke's claim of
7 patent infringement against TouchNet Information Services, Inc. and ORDERING that plaintiff
8 never again "assert United States patent No. 5,602,905 against defendant TouchNet Information
9 Systems, Inc., its customers, licensees or assigns. Protestor asserts that this dismissal represents
10 the realization by Plaintiff, Richard P. Mettke, as a result of the above deposition testimony, that
11 his claim was baseless and that his patent was invalid.

12 **Exhibit N**

13 Exhibit N is the Affidavit of Daniel J. Toughey which verifies the dates related to
14 all exhibits presented in this Protest.

15 **APPLICATION OF CITED REFERENCES**

16 Each of Exhibits A, B, E and F, taken individually, are believed to teach the particular
17 combination of structure claimed in the present reissue application. The applicant's claims to
18 connecting to a commercial on-line service also is anticipated by these references and Exhibit C.

19 The applicant's claims, in reissue, which are directed to claiming connection to a particular

1 on-line database, such as the Internet, are anticipated by the Protestor's advertising in printed
2 publications, as early as 1991, connection to the Prodigy on-line service. The applicant's claims
3 directed to connection to the Internet represent nothing more than a choice of on-line databases
4 from which a user might select.

5 Therefore, Protestor believes that Exhibits A, B, C, E and F, each individually, anticipate
6 under 35 U.S.C. § 102 (a) and (b) the claimed subject matter of the present reissue application.

7 The Protestor believes that Exhibit C in combination with either Exhibit A, Exhibit B,
8 Exhibit E, or Exhibit H, makes obvious, under 35 U.S.C. § 103, the original claims and the newly
9 claimed subject matter of the present reissue application. The only distinction between these
10 references and the claims of present reissue application is in the selection of the particular on-line
11 service or database for connection thereto by a user. The Protestor believes that such a choice of
12 one on-line service or database is merely a matter of user choice and that no inventive distinction
13 is represented by making such a choice.

14 Therefore, the Protestor believes that the present reissue claims, both the original claims
15 and the additional claims sought at reissue, are either anticipated or made obvious by the printed
16 publications cited in this paper.

CERTIFICATE OF SERVICE

I, Richard P. Stitt, hereby certify a copy of the foregoing PROTEST UNDER 37 C.F.R.
§ 1.291 and all exhibits identified therein were served via U.S. Mail, first class postage prepaid,
this 3rd day of November 1998, upon:

Edward W. Goldstein
Darin H Duphorne
TOBOR & GOLDSTEIN, L.L.P.
1360 Post Oak Blvd., Suite 2300
Houston TX 77056

Respectfully submitted,



RICHARD P. STITT
Patent Office Reg. No. 35,693
SPENCER FANE BRITT & BROWNE, LLP
1000 Walnut Street, Suite 1400
Kansas City, MO 64106
Telephone: (816) 474-8100
Facsimile: (816) 474-3216

Attorney for Protestor
TOUCHNET INFORMATION SYSTEMS, INC.